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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,342	03/12/2004	Dwight Allen Merriman	11032-3067	5601
23838	7590	03/18/2005	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			LANEAU, RONALD	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/798,342

Applicant(s)

MERRIMAN ET AL.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. The amendment filed on 01/13/05 has been entered. Claims 1-22 remain pending.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-15 and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Wexler (US 5,960,409).

As per claims 1-5, 9, Wexler teaches a method for advertising, comprising: receiving an advertisement request from a user node, wherein said advertisement request is based upon a link sent from an affiliate node to said user node in response to a content request sent from said user node to said affiliate node (col. 4, lines 54-57 and col. 5, lines 1-8); and selecting, in response to said advertisement request, an advertisement based upon stored information about said user node (col. 4, lines 61-67), the network consists of a plurality of nodes, wherein a user a first node (user node) views a first quantity of information provided by a second node (publisher) for the benefit of a fourth node (advertiser) (col. 6, lines 15-19).

As per claim 6, the system of Wexler inherently teaches a system wherein the stored information includes at least one of the network address of said user node, the domain type of

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said user node, the time zone of said user node, the geographical location of said user node, and an industry code for statistical purposes or satisfaction index calculation as claimed.

As per claim 7, Wexler teaches a system wherein said stored information includes the number of times an advertisement has been sent to said user node (col. 5, lines 26-29).

As per claim 8, Wexler teaches a system wherein selecting an advertisement is further based upon at least one of a browser type, a browser version, an operating system type, and a proxy server, each associated with said user node (col. 3, lines 29-31).

As per claims 9-14, Wexler teaches a system wherein if selection criteria associated with more than one advertisement are satisfied based upon said stored information, then calculating a satisfaction index for each advertisement, and selecting the advertisement with the lowest satisfaction index, wherein said satisfaction index for an advertisement is directly proportional to the number of times said advertisement is sent to a user node, wherein said satisfaction index for an advertisement is inversely proportional to the amount of time expired since said advertisement was first permitted to be sent to a user node, wherein said satisfaction index for an advertisement is inversely proportional to the maximum number of times the advertisement is permitted to be sent to a user node, wherein said satisfaction index for an advertisement is directly proportional to the total amount of time over which said advertisement is permitted to be sent (tallying clicks and generating statistics for multiple banner publishing site and multiple advertisers are equivalent to the satisfaction index calculation as claimed) (col. 5, lines 32-44).

As per claim 15, Wexler inherently teaches an advertisement request that would include an Internet Protocol address associated with a user node as claimed.

As per claim 19, Wexler teaches a system further comprising sending said selected advertisement to said user node for display (col. 5, lines 29-31).

As per claims 20-22, Wexler teaches a system comprising receiving from said user node a click through request for information about the advertiser associated with said selected advertisement, further comprising sending a network address for said advertiser to said user node in response to said click-through request, wherein said stored information includes information about a prior click-through request received from said user node (col. 3, line 65 to col. 4, lines 9, see abstract).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US 5,960,409).

As per claims 16-18, Wexler does not teach a system performing a reverse domain lookup table based upon an internet protocol address, selecting an advertisement based upon the results of said reverse domain and perform a trace operation route but it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a lookup table as claimed because it would increase flexibility of the system since arbitrary functions can be realized with lookup tables, the Official notice is taken as such.

***Response to Arguments***

5. Applicant's arguments filed 01/31/05 have been fully considered but they are not persuasive.

Applicant argues that Wexler does not disclose or suggest "selecting, in response to said advertisement request, an advertisement based upon stored information about said user node." Contrary to Applicant's arguments, Wexler discloses a banner wherein a user can click to access an advertiser web site through a third party. By clicking on the banner, the user sends a request signal to a third party web site which then redirect the request the advertiser web site which downloads the information originally sought by the user to his web browser. The user at the end does select an advertisement based upon stored information as claimed. In response to Applicant's arguments about the suggestion or motivations by the Office action, it is not necessary that the references actually suggest, expressly or in so many words, the changes or improvements that applicant has made. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. In re Sheckler, 168 USPQ 716 (CCPA 1971); In re McLaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCPA 1968). Applicant's arguments are deemed unpersuasive, claims 1-22 are finally rejected.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RL

Ronald Laneau  
Examiner

*Ronald Laneau* 3/11/05  
*Primary Examiner*